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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,959	07/30/1999	KEN HAYWARD	690-008568-U	1141

7590 12/31/2003

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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 12/31/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/364,959

Applicant(s)
Hayward et al

Examiner
Mark Wallerson

Art Unit
2626



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 14, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 4/14/03.
2. This application has been reconsidered. Claims 1-26 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "the image transfer device" in lines 9 and 10. There is insufficient antecedent basis for this limitation in the claim since two different image devices are disclosed in lines 7 and 8 of the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
7. Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Murai.

With respect to claims 1 and 5, Murai discloses an electronic assembly (figures 1 and 2) comprising an image transfer device (2) for reading and transferring an image from a first medium, the image transfer device including a reader (108) for reading the image on the first medium and a display (150) for displaying an image transfer menu for effecting transfer of the image between the image transfer device and another image transfer device (column 5, lines 48-50, column 9, lines 39-50 and figure 3); and a computer (4), wherein when the image transfer device is inactive or not in use, a first type of menu is displayed on the display device, and when the image transfer device is active, a second type of display menu is displayed (figure 3, 46; the abstract; column 4, line 66 to column 5, line 67; column 8, lines 47-63; column 13, line 21 to column 14, line 54 and column 66, line 20 to column 69, line 28).

With respect to claims 2 and 3, Murai discloses the image transfer device is a facsimile device (figure 1), and it includes a processor (200) for controlling operation of the device; a memory (202, 204, 206) and a user interface (figure 3).

With respect to claims 4 and 6-13, Murai discloses that the second type of image transfer menu is stored in the memory of the image transfer device, the computer has software for enabling the display means to display the first or second type of menu wherein at least a portion of the second type of the image transfer menu is stored in the computer and the second type menu includes expanded features for operating the image transfer device; the first type of menu includes

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a base set of different features which is commonly known for computer operations; the image transfer device is a fax machine and the extra feature is at least one of an extended phone log selection feature or adding a logo, message or watermark; the image transfer device is adapted to send a polling signal (figure 3, 45, 46, and 47; column 4, line 66 to column 5, line 67; column 8, lines 47-63; column 9, line 39 to column 10, line 67; column 13, line 21 to column 14, line 54; column 17, line 26 to column 18, line 57 and column 66, line 20 to column 69, line 28).

With regard to claims 14-18, Murai discloses the subject matter of claims 1-13 above.

With respect to claims 19-26, claims 19-26 are the method claims of claims 1-13.

Response to Arguments

8. Applicant's arguments filed 4/14/03 have been fully considered but they are not persuasive.

Applicant submits that Murai fails to disclose that the image transfer device has a first type and a second type of image transfer menu available for display depending on whether a computer is connected or not, where the image transfer menu is for affecting transfer of the image between the image transfer device and another image transfer device. The Examiner disagrees.

Murai discloses displaying various modes when the computer is connected and not displaying certain modes when the computer is not connected (the abstract); wherein the image transfer menu is for affecting transfer of the image between the image transfer device and another image transfer device (column 5, lines 48-51; column 9, lines 39-50 and figure 3).

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With respect to claim 5, Murai discloses the computer (4) stores a portion of the fax menu (column 10, lines 9-21 and column 18, lines 14-26).

With respect to claim 14, Murai discloses the second menu includes at least one feature of the first menu and extended features in comparison to the first menu (figure 3).

The elements of claim 19 are discloses in column 35, lines 9-16.

Conclusion

9. All claims are rejected.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

MARK WALLERSON
PRIMARY EXAMINER

Mark Wallerson